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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PICKARD, ALISON K

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 11/21/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
08/952,001

Applicant(s)
Carr

Examiner
Alison Pickard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 28, 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 55-92 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 56-58 and 88-92 is/are allowed.
- 6) ☒ Claim(s) 55, 60-62, 66-69, 73-78, 82-85, and 87 is/are rejected.
- 7) ☒ Claim(s) 59, 63-65, 70-72, 79-81, and 86 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

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DETAILED ACTION

1. Upon further consideration, the rejection of Claim 55 has been withdrawn. A new action follows.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 55 is rejected under 35 U.S.C. 103(a) as being unpatentable over Merwarth (605,891).

Merwarth discloses a gasket similar to applicant's comprising a first strip c, a second strip c³, and at least one spoke c². The first and second strips and the spokes are formed of a material adapted for sealing. Strips c and c³ are made of soft metal (page 2, lines 25-30) and c² is made of soft metal (page 2, line 46). Merwarth does not disclose that the soft metal of the strips c and c³ is the same as the soft metal of strip c². Forming the first and second strips and the spokes of the same material is considered a design choice. It is not considered inventive to select a known material base on its suitability for its intended use. See *In re Leshin*, 125 USPQ 416 (CCPA 1960). The first and second strips and the spokes all function as seals (see page 2 lines 33, 34, and 48). It is considered obvious to use the same material for the same function. Further,

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using the same material would provide ease in manufacturing considerations. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to make the first and second strips and the spokes of the same material as a matter of choice in design.

4. Claims 60-62, 66-69, 73-78, and 82-84 rejected under 35 U.S.C. 103(a) as being unpatentable over Mastin, U. S. Patent No. 1,245,002 in view of Smith, U. S. Patent No. 4,002,344.

Mastin discloses a gasket similar to applicant's comprising a first strip g', a second strip j, and at least one spoke k of sealing material (see Figure 3). A third strip (the inner most loop g') having an outer periphery less than the inner periphery of the first strip and a spoke extending between the third and first strips g' can be seen in Figure 3 as well. The strips and spokes are formed of the same sealing material and "are designed to produce a hermetic seal" (page 1, lines 23-27). Mastin does not disclose open or closed alignment spokes extending from the second strip.

Smith teaches the use of an open 46 and closed 51 alignment spoke which center a gasket between a variety of different sized flanges. The open spoke defines a concavity 48 and centering shelf 49. The closed spoke 51 has an aperture for a bolt and a tab portion 56 with identification data. These locators, 46 and 51, are taught to "accommodate different flange sizes, bolt circles, and bolt diameters" (col. 1, lines 35-37). Therefore, flanges with different outer peripheries could be used so that the locator or alignment spoke is congruent with a larger outer flange while

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the outer or second strip is congruent with a smaller outer flange. As for making the alignment spokes out of the sealing material used for the strips and spokes, Mastin discloses using the ribs or ridges (spokes or strips) around openings to produce a hermetic seal. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to include an open or closed alignment spoke as taught by Smith extending from the second strip out of the sealing material to provide a gasket which can be properly aligned between a variety of different sized flanges which would provide an efficient seal at the inner and outer edges of the flanges as well as around the bolt holes.

5. Claim 85 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mastin.

Mastin discloses a gasket similar to applicant's comprising a first and second strip and at least one spoke. However, Mastin's outer or second strip is not formed in a square shape. Using a square shape is considered a design choice as applicant has not stated that using a square rather than a circle solves any stated problem or is for any particular purpose. See *In re Dailey*, 149 USPQ 47 (CCPA 1966). Further, it appears that the circular shape of Mastin would perform equally as well. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to form the second strip with a square shape as a matter of choice in design since applicant has not shown any criticality to the shape.

6. Claim 87 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mastin as applied to claim 85 above, and further in view of Smith.

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As mentioned above, Mastin does not include a closed alignment spoke which can receive a bolt. Smith teaches the use of a closed 51 alignment spoke to center a gasket between a variety of different sized flanges. The closed spoke 51 has an aperture for a bolt. The closed spoke 51 is taught to “accommodate different flange sizes, bolt circles, and bolt diameters” (col. 1, lines 35-37). As for making the alignment spokes out of the sealing material used for the strips and spokes, Mastin has disclosed that this is desirable so as to provide a seal around the holes. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to include a closed alignment spoke as taught by Smith extending from the second strip out of the sealing material to provide a gasket which can be properly aligned between a variety of different sized flanges which would provide an efficient seal at the inner and outer edges of the flanges as well as around the bolt holes.

Allowable Subject Matter

7. Claims 56-58 and 88-92 are allowed.
8. Claims 59, 63-65, 70-72, 79-81, and 86 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Response to Arguments

9. Applicant's arguments filed 8-28-01 have been fully considered but they are not persuasive.

As stated above, upon further consideration a new rejection has been applied to claim 55. Merwarth has disclosed that the strips and spokes are made of a soft metal. Whether the soft metals are the same soft metals is unclear. However, it is clear that the strips and the spokes are made of a soft metal to form an "efficient seal" at the inner and outer edges of the pipe sections and around the bolt holes (page 2, lines 34, 35, and 48). It would be an obvious design choice to use the same material for the strips and spokes, especially since they all function as seals. Using the same material would also provide ease in manufacturing considerations. Further, the figures do not denote a difference in materials, nor does the specification specifically state they are different materials. The specification states "a soft metal" and "the soft metal" (page 2, lines 46 and 47). Applicant is splitting hairs over legal semantics which were not applicable at the time of the patent, which was 1898.

Applicant has also argued that Merwarth discloses the use of solder and thus some portions of the gasket would have a different sealing material (the solder) than the material of the strips and spokes. This argument is unpersuasive. Applicant uses "comprising" in the claims, thus making it open ended. The prior art can have additional components as long as it includes the limitations of applicant's claimed invention, which Merwarth does.

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In response to applicant's argument that the locator of Smith is not used to form a seal and therefore there is no motivation to form the locator of the same sealing material as the rings, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Smith provides motivation to use an alignment spoke (open or closed) for locating. Mastin already discloses using sealing material around openings to produce a seal. Therefore, combining the teaching of locating (from Smith) with the gasket taught by Mastin would produce applicant's invention as claimed.

Regarding claim 85, making the outer loop square is considered a design choice. Applicant has argued the square would have a mechanical function of centering on a circular pipe flange. However, these features are not claimed. Also, there is no criticality supported in the specification as to the shape, and to allow it in would be new matter. Furthermore, a square loop would only provide applicant's proposed benefits on a circular flange of appropriate size. A square loop on a flange with a substantially larger outer periphery would not serve to center any better than a circular loop.

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Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alison Pickard whose telephone number is (703) 305-0882.



Anthony Knight
Supervisory Patent Examiner
Group 3600

AP

November 19, 2001